

REMARKS

Claims 1, 2, 24, 28, 43 and 44 were pending in the application. By way of this amendment, claim 1, claim 24 and claim 44 have been amended. Support for the claim amendments can be found in the original application and claims as filed. No new matter has been added.

Upon entry of this amendment claims 1, 2, 24, 28, and 43 – 44 will be pending.

Claim 1 is amended to clarify the scope of the subject matter encompassed by the claim, and now recites that the mammal has a large gene deletion in a gene encoding Factor IX which can result in generation of inhibitory antibodies to Factor IX upon administration of exogenous Factor IX, support for which can be found at page 10, lines 15 – 18, page 11, lines 4 – 6, and page 13, lines 3 – 5 of the specification.

Claim 24 has been amended to more clearly describe the effects of the large deletion in the gene encoding Factor IX, support for which can be found at page 13, lines 7 – 12. Claim 44 has been amended to recite intramuscular administration of the AAV which is supported by the disclosure at page 13, line 13.

In addition, the specification is amended to provide a complete citation to a journal article relating to a murine model of hemophilia, thus addressing the Examiner's objection to the specification. Specifically, the partial citation "Blood 90:3962" has been completed to recite "Lin *et al.*, 1997, A Coagulation Factor IX-Deficient Mouse Model for Human Hemophilia B, Blood, 90:3962–3966", which amendment is supported by the context in the specification of the partial citation and the fact that volume 90 of the journal Blood was published in 1997. Thus, the completion of the citation adds no new matter.

Information Disclosure Statement

An Information Disclosure Statement (IDS) is being filed concurrently herewith. Entry of this IDS is respectfully requested. Also included is the requisite fee for having a reference considered after receipt of an official action on the merits.

Claims 1, 2, 24, 28, 43 and 44 Satisfy the Enablement Requirement of 35 U.S.C. §112,**First Paragraph**

The 20 January 2010 Official Action and the references cited therein have been carefully reviewed. In view of the amendments presented herewith and the following remarks, favorable reconsideration and allowance of this application are respectfully requested.

At page 2 of the 20 January 2010 Official Action, the Examiner has maintained, in modified form, the rejection of claims 1, 2, 24, 28, 43 and 44 under 35 U.S.C. §112, first paragraph, for allegedly failing to comply with the enablement requirement. Applicants respectfully traverse this rejection.

Specifically, at page 3 of the 20 January 2010 Official Action, the Examiner alleges that the specification

does not reasonably provide enablement for a method of preventing the formation of inhibitory antibodies to Factor IX delivered to a mammal having any other defect which can result in generation of antibodies to Factor IX.

Applicants strenuously disagree with the characterization of the prior art set forth by the Examiner. However, in an effort to expedite prosecution, Applicants have amended claim 1 to recite that the particular defect is a large gene deletion in a gene encoding Factor IX, which is clearly supported by the examples of the instant specification. The mouse model used by Applicants “comprises a large deletion in the gene encoding F.IX” (see page 10, lines 16 – 17). Moreover, claim 1 has been amended to clarify that the generation of inhibitory antibodies results upon administration of exogenous Factor IX, support for which can be found at page 11, lines 4 – 6. Additionally, claim 24, which depends from claim 1, has been amended to describe the effects of the large deletion in the gene encoding Factor IX, and recites that the large gene deletion results in no endogenous expression of Factor IX, support for which can be found at page 13, lines 7 – 12. Applicants submit that claim 24 as amended is also fully enabled. Finally, claim 44 has been amended to require intramuscular administration of the vector.

In view of all of the foregoing, Applicants submit that the specification fully enables the presently claimed method. Accordingly, Applicants request that the rejection of claims 1, 2, 24, 28, 43 and 44 under 35 U.S.C. §112, first paragraph be withdrawn upon reconsideration.

CONCLUSION

It is respectfully requested that the amendments presented herewith be entered in this application. The amendments and accompanying remarks are believed to clearly place the pending claims in condition for allowance. Therefore, it is respectfully urged that the rejections set forth in the 20 January 2010 Official Action be withdrawn and that this application be passed to issue. Given the lengthy prosecution of this Application, the Examiner is requested to contact the undersigned if this amendment does not place the claims in condition for allowance in order to discuss claim language that is mutually acceptable to both parties that will result in the

issuance of this application.

If a fee is required or an overpayment is made, the Commissioner is authorized to charge or credit the deposit account of the undersigned, Account No. 04-1406.

Early and favorable action on the present application is earnestly solicited.

Respectfully submitted,

DANN DORFMAN HERRELL and SKILLMAN, P.C.
Attorneys for Applicants

Date: 20 April 2010

/Robin S. QUARTIN/

Robin S. Quartin, J.D., Ph.D.
Registration No. 45,028

Customer Number: 000110
Telephone: 215-563-4100
Facsimile: 215-563-4044
E-mail: rquartin@ddhs.com